

REMARKS

Claims 1-17 and 19-26 remain pending in the application.

The office action objects to claim 2 and dependent claims 3, 4, 12, and 14 because it is ostensibly incorrect for claim two to refer to "each exhaust system" rather than to -- each chamber --. The applicant maintains that the claim is correct as written, since each exhaust system is provided with an exhaust valve as claimed.

The office action objects to claims 3 and 19 because there is no antecedent basis for the step of "operating the exhaust system." In response, the applicant has amended claims 3 and 19 to include proper antecedent basis.

The office action rejects claims 1-3, 9, 16, 19-23, 25 and 26 under 35 U.S.C. § 102(b) as being anticipated by Bullard (US4865020).

Regarding independent claims 1 and 20 the office action indicates that the Bullard pressure cuffs satisfy the claim 1 limitation: "providing a body support system", and the claim 20 limitation: "body support apparatus". The applicant maintains that Bullard neither discloses nor suggests that the pressure cuffs are either capable of supporting a body or that they might be modified to support a body. Instead, Bullard discloses a pressure cuff that, rather than supporting a body, is supported *by* a body *part* such as a limb or a torso. Nevertheless, to remove any doubt regarding whether these claims might be construed to cover pressure cuffs, the applicant has further limited claim 1 to recite the provision of a seat and has further amended claim 20 to recite a seat apparatus. The applicant maintains that Bullard doesn't anticipate amended claim 1 or amended claim 20.

Regarding claims 2-3, 9, 16, 19, 21-23, 25, and 26, the applicant maintains that these claims are allowable because they depend from allowable base claims.

The office action rejects claims 1, 20, and 23 under 35 U.S.C. § 102(b) as being anticipated by Takeuchi (US4622706).

Takeuchi discloses an air mat that can be laid on a bed or a chair and might arguable be described as a body support as previously claimed. However, with regard to amended claim 1, laying this mat on a chair does not meet the limitation to “providing a seat including more than one expandable chamber and including a pressure system and an exhaust system connected to each expandable chamber.” While one might argue that Takeuchi suggests providing a seat and then, in a separate step, providing a mat on the seat (a mat that includes expandable chambers and pressure and exhaust systems), Takeuchi neither teaches nor discloses a step of providing a seat that, itself, includes each of those structures. Accordingly, the applicant maintains that Takeuchi does not anticipate amended claim 1.

Similarly, with regard to claim 20, Takeuchi suggests a matt laid on a chair, where the mat includes expandable chambers, and pressure and exhaust systems. However, Takeuchi neither teaches nor suggests a *seat* that incorporates these structures. Accordingly, the applicant maintains that Takeuchi doesn’t anticipate amended claim 20.

The applicant maintains that claim 23 is allowable because it depends from an allowable base claim.

The office action rejects claims 1-8, 10-15, 17, and 19-24 under 35 U.S.C. § 103(a) as being unpatentable over Gillen in view of Bullard.

Apparently regarding independent method claim 1 and article claim 20, the Action indicates that Gillen discloses the method as claimed except that the Gillen does not disclose the step of causing the exhaust system to actively draw fluid from the chambers.

The applicant maintains that neither Gillen nor Bullard disclose a method that either includes or suggests the step of providing a seat including more than one expandable chamber.

The applicant additionally maintains that the commercial success of the invention, as set forth in the accompanying Declaration of Derren Rogers, militates against a finding of obviousness.

For these reasons the applicant maintains that claims 1 and 20 are patentable over Gillen in view of Bullard.

The applicant maintains that dependent claims 2-7, 10-15, 17, 19, and 21-24 are allowable because they depend from allowable base claims.

The applicant additionally maintains that claims 2-7, 10-15, 17, 19, and 21-24 are allowable because there is no motivation to be found, either in the prior art or in knowledge generally available to one of ordinary skill in the art, to arrive at the inventions recited in these claims by combining Gillen and Bullard. The applicant further maintains that the office action has not presented a *prima facie* case for obviousness regarding any of these claims because the office action doesn't show evidence of a motivation to combine Gillen and Bullard with regard to any of these claims. Instead, the office action either provides no rationale at all or merely identifies advantages that the combination would realize. For example, with regard to claims 10-11 and 13 the office action states that it would have been obvious to combine the references to arrive at these

claims “for the purpose of providing desirable manner (sic) in which the user’s back can be massaged in a particular sequence that would suit the user’s need.” Similarly, with regard to claims 12 and 14 the office action states that it would have been obvious to combine the references “for the purpose of providing a wide variety desirable (sic) massaging types in which the user’s back can be massaged in a particular sequence that would suit the user’s need.”

Evidence of motivation to combine may come in the form of an express teaching or suggestion in the prior art or in knowledge generally available to one of ordinary skill in the art. *See, e.g., In re Oetiker*, 24 USPQ2d 1443, 1446-1447 (Fed. Cir. 1992). Evidence of motivation may also be found in “the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem.” *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.* 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); *See also, e.g., In re Rinehart*, 189 USPQ 143, 149 (CCPA 1976); *In re Rouffet*, 47 U.S.P.Q.2d 1453, at 1458 (Fed. Cir. 1998); *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.* 37 USPQ2d 1237, 1240 (Fed. Cir. 1995); *In re Oetiker* at 1446-1447. In other words, if an examiner is unable to find evidence of motivation in an express teaching or suggestion in the prior art or knowledge generally available to one of ordinary skill in the art, the examiner can still show an implicit motivation to combine with evidence that one skilled in the art, confronted with the same problem as the inventor, would know to use a prior art teaching to solve that problem, i.e., the problem that the applicant sought to solve through the invention in question. *Id.* For this to be the case, the problem that the invention solves must be the same as or at least similar to the problem that the prior art teaching solves. *In re Rinehart* at 149; *Para-Ordinance* at 1240; *Motorola, Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001).

However, it’s not enough to simply identify an advantage that the suggested combination would share with the claimed invention. If the combination reaches the invention, then it will *always* and *necessarily* provide the same advantages as the

invention. To conclude that an invention is obvious because a combination of prior art references that produces the same invention would provide the same advantages, is no different from defining an obvious invention as being one that provides the same advantages as itself. Since this is true of all inventions, the existence of such an advantage is incapable of distinguishing between obvious and non-obvious inventions.

To distinguish between obvious and non-obvious combinations one must instead produce evidence of a teaching or suggestion that would have motivated one skilled in the art to combine those particular references in such a way as to *realize* the advantage. To reason that the advantage of the combination can, itself, serve as the motivation to combine is, therefore, essentially tautological. It short-circuits the proper analysis and can be used to characterize *any* inventive combination as being obvious.

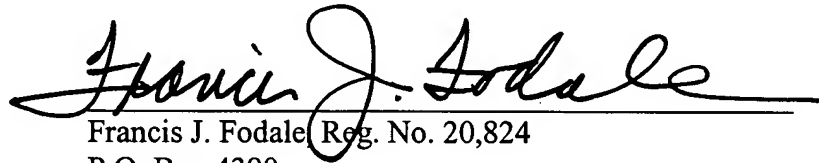
If we are to accept such general advantages as “providing a way to massage a user’s back in a particular sequence that would suit the user’s need” or “providing a wide variety of massage types from which a user can select to suit the user’s need” as serving as a common “problem to be solved,” then we should also accept “providing a way to save money” or “providing a way to make more money” or “providing a way to make a better invention” as problems to be solved that provide an acceptable source of motivation in the form of “economic optimization.” This could not have been the Federal Circuit’s intent when it established this test since it would, as explained above, preclude any combination from being patentable (since virtually all inventions comprise pre-existing technology combined in a novel way to provide economic benefit to the inventor or the inventor’s assignee). Under the true test, it’s only when an examiner finds identity (or at least similarity) between the *specific* problem solved by the inventor and a problem solved by a prior art reference, that the examiner can fairly conclude that the invention is obvious, or, in other words, the pertinent motivation is a motivation to make obvious the technologic advance, not the omnipresent motivation to provide a competitive advantage or provide economic benefit.

The applicant maintains that claims 1-17 and 19-26 are in allowable form and respectfully requests their allowance.

I authorize the Assistant Commissioner to charge any deficiencies, or credit any overpayment associated with this communication to Deposit Account No. 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.

A handwritten signature in cursive script, reading "Francis J. Fodale", written over a horizontal line.

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Date: February 14, 2005

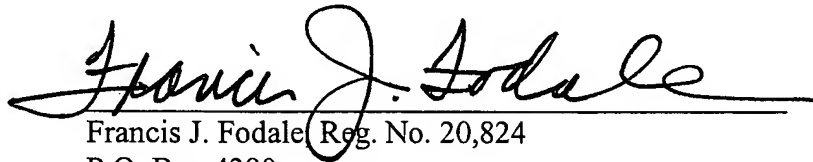
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